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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,458	06/22/2000	Alan B. Hamor	3835-4002	8724

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/598,458

Applicant(s)
Hamor et al

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 22, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4-6 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 53 recites the limitation "the compensation value" in line 2. There is insufficient antecedent basis for this limitation in the claim. This feature was first disclosed in Claim 52, not Claim 51. The Examiner believes that this is a typographical error and will consider Claim 53 as dependent upon Claim 52. Appropriate correction is required.

Claim Objections

3. Claims 75-77 are objected to because of the following informalities:

Claim 75-77 are each dependent upon Claim 66. The Examiner believes that this is a typographical error and that Claim 75 should be dependent upon Claim 74, and Claims 76 and 77 should be dependent upon Claim 75. The Examiner and will consider each claim using these dependencies. Appropriate correction is required.

Art Unit: 3622

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-10, 12-15, 30-39, 44-56, 64, 65, and 82-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al (5,933,811).

Claims 1, 30, 47-49, 51-53, 55, 64, and 82-86: Angles discloses a system and method for delivering customized advertisements over interactive communication networks, comprising:

- a. Transmitting a controlling program to a client (col 3, lines 25-29);
- b. Transmitting a content page to the client from a content provider (col 3, lines 9-17;
- c. Receiving client impressions (interactions) to the content page (col 3, line 66 - col 4, line 5); and
- d. Calculating content provider revenue based on the total number of client impressions from the content provider (col 4, lines 18-26).

Art Unit: 3622

Claims 2-6 and 87-91: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 85 above, and further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

Claims 7-10 and 32-35: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the client impressions include delivering, printing, saving, or transmitting (col 16, lines 1-34).

Claims 12-14, 38, and 46: Angles discloses a system and method for delivering customized advertisements over interactive communication networks as in Claim 1 above, and further discloses targeting the advertisement based upon the client profile, accessed content, or the content page (col 15, lines 22-28).

Claims 15, 31, 44, and 45: Angles discloses a system, method, and computer program for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the total revenue pool comprises the total number of advertisements multiplied by the price per advertisement (col 16, lines 1-34).

Claim 36: Angles discloses a method for delivering customized advertisement over interactive communication networks as in Claim 30 above, and further discloses that the client impressions include searching (col 16, lines 1-34).

Art Unit: 3622

Claims 37, 39, 50, 54, 56, and 65: Angles discloses a system and method for delivering customized advertisement over interactive communication networks as in Claims 30, 38, 47, 51, 55, and 64 above, and further discloses that the client impressions include delivering, printing, saving, or transmitting (col 16, lines 1-34).

6. Claims 74, 75, 78, and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerszberg et al (6,044,403).

Claims 74 and 78: Gerszberg discloses a method for sending coupons to a client on a network, comprising:

- a. Transmitting a host with a fac value (i.e. coupon) to a client (col 12, lines 18-48);
- b. Storing the coupon in the client's memory (col 12, lines 18-48); and
- c. Transmitting the coupon to a remote location (i.e. merchant), wherein the client receives a discount on goods or services according to the face value of the coupon (col 12, lines 18-48).

Claims 75 and 79: Gerszberg discloses a method for sending coupons to a client on a network as in Claims 74 and 78 above, and further discloses that the value of the coupon may vary while stored on the client's memory (col 12, lines 18-48).

Art Unit: 3622

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811).

Claim 11: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claim 1 above, but does not explicitly disclose that the host is always visible to the client when active. Official Notice is taken that it is old and well known within the computer arts to assign priorities to the windows being displayed to a client. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place a high priority on the host window to make it always visible to the client. One would have been motivated to keep the host visible to the client in order to increase the exposure of the client to the advertisement.

9. Claims 16-29, 40-43, 57-63, and 66-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Logan et al (5,721,827).

Art Unit: 3622

Claims 16, 17, 27, 40, 42, and 43: Angles discloses a system and method for delivering customized advertisement over interactive communication networks, comprising:

- a. Grouping advertisements according to topic, user profiles, or other criteria (col 15, lines 39-42 and col 20, lines 59-63);
- b. Assigning/transmitting a controlling program to a client (col 3, lines 25-29 and col 13, lines 61-67); and
- c. Transmitting a plurality of advertisements to the controlling program (col 15, lines 28-31).

Angles does not explicitly disclose that the plurality of advertisements are organized into an advertising wheel (i.e. queue), nor that the advertisements in the queue are transmitted to the controlling program in succession. Logan discloses a similar system and method for delivering customized advertisements over interactive communication networks and also discloses organizing the plurality of advertisements into a queue and transmitting a plurality of advertisements to the client in sequence from the queue (col 9, lines 57-63). Since an advertisement only appears once in the queue, it is inferred that the advertisement will only be transmitted once during each cycle of the queue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to organize linked advertisements in Angles into one or more advertising wheels/queues and to transmit each advertisement in the queue to the client in sequence once during each cycle of the queue. One would have been motivated to use an advertising wheel/queue in this manner in order to enable

Art Unit: 3622

the system to present serial advertisements (similar to the old Burma Shave commercials alongside of American roadways for the past 50-60 years) in the proper sequence and to preclude the repetitive delivery of the same advertisement.

Claim 18: Angles and Logan disclose a method for delivering customized advertisement over interactive communication networks as in Claim 16 above. Logan further discloses placing all of the similarly classified advertisements into one large queue (col 9, lines 57-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place all of the similar advertisements in Angles in one large queue. One would have been motivated to use one large queue in order to ensure that an advertisement is not transmitted to the client more than once before all other similar advertisements have been transmitted.

Claims 19-26, 41, 57-63, and 66-73: Angles and Logan disclose a system and method for delivering customized advertisements over interactive communication networks as in Claims 18 and 40 above. Logan further discloses that advertisements on one queue are subdivided into linked auxiliary wheels (sub-queues_ according to various similar features (col 24, line 1 - Col 26, line 3). The various claimed features used to divide the advertisements are among the usual features used by advertisers when deciding how to target clients. The exact individual feature, or group of features, selected by the advertiser is a design decision which does not affect the steps of the invention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to subdivide the advertisements in Angles into any number of linked sub-queues, based on whichever features the advertiser desires. One would have been motivated

Art Unit: 3622

to subdivide the advertisements and to link the sub-queues in order to better target the advertisements to the client.

Claims 28 and 29: Angles and Logan disclose a method for delivering customized advertisements over interactive communication networks as in Claim 16 above. Angles further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

10. Claims 76, 77, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al (6,044,403).

Claims 76, 77, 80, and 81: Gerszberg discloses a method for sending coupons to a client on a network as in Claims 74 and 78 above, but does not explicitly disclose that the value is an interest rate or a time value discount. Official Notice is taken that it is old and well known that coupons may consist of any number of innumerable terms to include, cents-off discounts, percentage discounts, rebates, various time sensitive terms, buy-one-get-one-free discounts, etc. Again, the exact terms and types of values offered would be a design decision made by each individual advertiser and would not affect the claimed delivery method. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the coupons being delivered in Gerszberg could contain any of these known terms to include an interest rate or a time value discount. One would have been motivated to allow the coupons to

Art Unit: 3622

have various types of terms in order to expand the utility of the coupon delivery system to cover many types of advertisers.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
September 27, 2002



James W. Myhre
Patent Examiner
Art Unit 3622